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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,484	11/05/2003	Nestor J. Santi	03068.001200	7754

5514 7590 06/07/2005

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NEW YORK, NY 10112

EXAMINER

PEAVEY, ENOCH E

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/700,484	SANTI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Enoch E Peavey	3676	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 35-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 45-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/11/05, 3/3/04 &amp; 1/15/03</u>                                         | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

I. Applicant's election with traverse of Group I in the reply filed on April 1, 2005 is acknowledged. The traversal is on the ground(s) that the inventions are not both independent and distinct. This is not found persuasive because the product can be made by a materially different method as described in the March 8, 2005 restriction requirement. The fact that there may be some overlap in the search is immaterial, there is no requirement that the inventions be free of overlapping search.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

II. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 1, 11-16 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson et al. US No. 4,508,375 ("Patterson"), in view of Butler, US No. 4,696,499 ("Butler").

Patterson discloses a radially expandable threaded tubular assembly comprising: a radially expandable male threaded element having external male threading and a first free end,

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the external male threading including a first incomplete thread and a first hooked thread,

the first incomplete thread being located at least adjacent the first free end of said male threaded element; a radially expandable female threaded element having internal female threading and a second free end, the internal female threading including a second incomplete thread and a second hooked thread, the second incomplete thread being located at least adjacent the second free end of said female threaded element,

said female threaded element being threadedly engaged with said male threaded element (FIG. 4);

Patterson does not disclose an elastomeric sealant extending between the external male threading and the internal female threading and adhering to both the external male threading and the internal female threading.

Butler discloses such an arrangement in order to prevent fluid leakage between the joint (Col. 3, lines 29-30 and 33-35).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Patterson as taught by Butler in order to prevent fluid leakage between the joint.

B. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson et al. US No. 4,508,375 ("Patterson"), in view of Flagg, US No. 2,145,168 ("Flagg").

Patterson discloses the same assembly as described above except for the first and second metallic coatings disposed respectively on male and female threads.

Flagg disclose such a coating in order to maintain an absolute seal and prevent leakage (Page 1, para. 1, line 8).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Patterson as taught by Flagg in order to maintain an absolute seal and prevent leakage.

C. Claims 2-10 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson and Butler as applied to claims 1, 11-16 and 45 above, and further as a matter of optimization.

1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the sealant to find the optimum range in which sealing occurs, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233,235 (CCPA 1955)

D. Claims 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson and Flagg as applied to claim 17 above, and further as a matter of optimization.

2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating to find the optimum range in which sealing occurs, since it has been held that where the general conditions of a claim are disclosed

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in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233,235 (CCPA 1955)

III. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Enoch E Peavey whose telephone number is (571) 272-7061. The examiner can normally be reached on Mon-Fri 8:00 am to 4:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Enoch E Peavey  
Primary Examiner  
Art Unit 3676



June 1, 2005